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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,680	12/06/2000	Arthur S. Haseltine	437-4	9308

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EXAMINER

ROBINSON BOYCE, AKIBA K

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/731,680

Applicant(s)

HASELTINE, ARTHUR S. 8

Examiner

Akiba K Robinson-Boyce

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-26, 28-33 and 35-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-26, 28-33 and 35-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Due to communications filed 9/14/04, the following is a non-final office action. Claims 21, 22, 27 and 34 have been cancelled. Claims 23-26, 28-29, 31-33, 35-37 and 40 have been amended. Claims 23-26, 28-33 and 35-40 are pending in this application and have been examined on the merits. The previous rejection has been withdrawn, and the following reflects the claims as amended. Claims 23-26, 28-33 and 35-40 are rejected as follows.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 23-26, 28-33 and 35-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers et al (US 6,018,719), and further in view of Kramer et al (US 6,324,525).

As per claim 24, Rogers et al discloses:

a distributed purchasing public of remote merchandisers' merchandise, (Col. 3, lines 61-64, [local retailer computer at a central station with links to registers at individual stores], w/ col. 4, lines 49-51, [where customer is shown to bring merchandise to the register for a product transaction, therefore, customers can be located at different individual stores]);

a plurality of remote merchandisers transacting sales accompanied in each instance by a form of record thereof, whereby the merchandisers likely desire greater physical distribution among their distributed purchasers...for sake of offering proximity for walk-in return service, (Col. 4, lines 7-13, [regional computer system for a large chain of stores], Col. 3, lines 59-61, [having the local computer system located in proximity to the register, thus making it advantageous and more effective for product transactions]);

a network of distributed point-of-return associates providing a network of distributed, physical stores in which to process the walk-in return business of the remote merchandisers, (Col. 3 lines 61-64, [retailer computer links to the registers at individual stores], w/ Col. 8, lines 8-19, [retailer {sales associate} cross-referencing the serial number of the product with the serial number on the receipt to verify the sales receipt]);

an association resource providing merchandise-return information services for exchange among the point-return associates over a communications medium, (Col. 8, lines 20-34, [scan and link to serial number, exchange]); and

an out-sourced merchandise-return program configured such that the point-of-return associates accept the walk-in returns of the merchandisers' merchandise upon authorization received from the merchandise-return information services based on the input of information from the form of record for the merchandise, (Abstract, lines 1-3, [facilitates authorized product returns], w/ Col. 8, lines 20-36, [where records are represented by information in the retailer/manufacturer database and the authorization

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is represented by making sure qualifications are met], w/ Col. 4, lines 24-26, [where database is shown to store transaction information about merchandise]);

whereby said out-sourced merchandise-return system affords the point-of-return associates expanded opportunities to increase public traffic by offering to process returns for the remote merchandisers, (Col. 8, lines 7-19, [shows the customer returning the product to the store if the customer is not satisfied with the product and the sales associate processing return by first comparing the serial number on the product with that on the receipt. In this case, the opportunity to increase public traffic is obvious with Rogers et al because if the customer must return the product, he/she must complete this return transaction for the product at the register, which is located at the store, therefore, the traffic at the store will increase with each return]).

Wherein the association resource is a resource for merchandise-return information corresponding to information on original sales transactions by which a given merchandiser fulfilled or caused fulfillment of orders of merchandise, (Col. 8, lines 20-34, [where scanning is for serial numbers of products that were previously purchased]).

wherein the plurality of remote merchandisers deal in a wide variety of differing goods, (Col. 4, lines 51-55, [super Nintendo, Game boy, Virtual boy, etc.]).

I would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to increase public traffic by offering to handle returns for the remote merchandisers with the motivation of getting customers to come to the point-of-return at the business for a return transaction, thereby creating more business for the business organization.

Rogers fails to disclose and the distributed community of point-of-return associates generally provide retail mail, parcel and shipping services generally not directly competitive with the goods of the merchandisers, but does disclose point-of-return associates in the abstract, lines 3-5.

However, Kramer et al discloses and the distributed community of point-of-return associates generally provide retail mail, parcel and shipping services generally not directly competitive with the goods of the merchandisers, (Col. 30, lines 5-9, shows a return transaction captured by vPOS or the virtual point of sale, w/ col.15, lines 4-9, shows that when the cardholder/consumer places an order for goods, the shipping cost is presented. Kramer et al discloses this limitation in an analogous art for the purpose of showing that products that are returnable can be shipped. Kramer et al does not specifically disclose retail mail, or parcel, however, these are obvious with Kramer et al since Kramer et al discloses shipping services, which is also a delivery service like retail mail and parcel services.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to provide retail mail, parcel and shipping services with the motivation of showing that delivery services are available with product-return systems.

As per claims 23, 30, Rogers et al fails to disclose one of electronic or non-electronic forms of records attached to returnable units of merchandise during or before order fulfillment wherein the forms facilitate research of information with the association service, but does disclose a returnable unit of merchandise in the abstract, lines 11-14.

However, Kramer et al discloses:

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one of electronic or non-electronic forms of records attached to returnable units of merchandise during or before order fulfillment wherein the forms facilitate research of information with the association service, (Col. 15, lines 2-10, electronic order form). Kramer et al discloses this limitation in an analogous art for the purpose of showing that a form pertaining to a transaction can be delivered electronically before the order is authorized and processed. In this case, attaching the form to the unit is obvious since the form can be created on the cardholder's computer, which has a printer for printing out the form, and it is standard practice to include a return order slip when returning merchandise in the parcel industry.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have one of electronic or non-electronic forms of records attached to returnable units of merchandise during or before order fulfillment wherein the forms facilitate research of information with the association service with the motivation of making information about the return readily accessible.

As per claims 25, 32, 40, Rogers et al discloses:

wherein the association resource and at least some of the distributed community of point-of-return associates are part of a common organization/wherein said merchandise return system and at least some of the distributed community of point-of-return associates are under common ownership or control, (Col. 3, lines 61-63, [chain stores]).

As per claims 26, 33, Rogers et al discloses:

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wherein the association resource exchanges information over the communications medium with at least some of the plurality of remote merchants, (Col. 8, lines 20-28, [linking to manufacturer database and authorizing by checking dates and qualifications]).

As per claim 28, Rogers et al discloses:

wherein the pertinent return-acceptance criteria are communicated in a message further comprising return fulfillment instructions in cases if the pertinent return acceptance criteria are met, (Col. 8, lines 29-36, [shows fulfillment instructions by identifying to the associate that if products were purchased within the past 90 days and also meet all other manufacturer return qualifications, that these products can be refunded or exchanged], w/ Col. 8, line 55-Col. 9, line 1, [shows that consumer's return options are displayed to the associate]).

As per claim 29, Rogers et al discloses:

the association resource is a resource for merchandise-return information corresponding to information on original sales transactions by which a given merchandiser fulfilled or caused fulfillment of orders of merchandise, (Col. 8, lines 20-34, [where scanning is for serial numbers of products that were previously purchased]).

As per claims 31, 39, Rogers et al discloses:

a distributed purchasing public of remote merchandisers' merchandise, (Col. 3, lines 61-64, [local retailer computer at a central station with links to registers at individual stores], w/ col. 4, lines 49-51, [where customer is shown to bring merchandise

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to the register for a product transaction, therefore, customers can be located at different individual stores]);

a plurality of remote merchandisers that likely desire greater physical distribution among their distributed purchasers of...centers for sake of offering proximity for walk-in return service, (Col. 4, lines 7-13, [regional computer system for a large chain of stores], Col. 3, lines 59-61, [having the local computer system located in proximity to the register, thus making it advantageous and more effective for product transactions]);

a network of distributed point-of-return associates providing a network of distributed, physical stores in which to handle the walk-in return business of the remote merchandisers, (Col. 3 lines 61-64, [retailer computer links to the registers at individual stores], w/ Col. 8, lines 8-19, [retailer {sales associate} cross-referencing the serial number of the product with the serial number on the receipt to verify the sales receipt]);

an association resource providing merchandise-return information services for exchange among the point-return associates over a communications medium and being a resource of information pertaining to the merchandise of the remote merchandisers including pertinent return acceptance criteria, (Col. 8, lines 20-34, [scan and link to serial number, exchange, where the acceptance criteria is represented by return qualifications]); and

an out-sourced merchandise-return program arranged such that the point-of-return associates accept the walk-in returns of the merchandisers' merchandise if after contact with the merchandise-return information services the pertinent return-acceptance criteria are met, (Abstract, lines 1-3, [facilitates authorized product returns],

w/ Col. 8, lines 20-36, [where records are represented by information in the retailer/manufacturer database and the authorization is represented by making sure qualifications are met where criteria is represented by qualifications], w/ Col. 4, lines 24-26, [where database is shown to store transaction information about merchandise])

whereby said out-sourced merchandise-return system affords the point-of-return associates expanded opportunities to increase public traffic by offering to handle returns for the remote merchandisers, (Col. 8, lines 7-19, [shows the customer returning the product to the store if the customer is not satisfied with the product and the sales associate processing return by first comparing the serial number on the product with that on the receipt. In this case, the opportunity to increase public traffic is obvious with Rogers et al because if the customer must return the product, he/she must complete this return transaction for the product at the register, which is located at the store, therefore, the traffic at the store will increase with each return])).

wherein the plurality of remote merchandisers deal in a wide variety of differing goods, (Col. 4, lines 51-55, [super Nintendo, Game boy, Virtual boy, etc.])).

I would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to increase public traffic by offering to handle returns for the remote merchandisers with the motivation of getting customers to come to the point-of-return at the business for a return transaction, thereby creating more business for the business organization.

The following is not disclosed by Rogers:

of brick-and-mortar centers

However, brick and mortar centers are in the same category as a store. For example, Home Depot is a store where a consumer can buy and/or return bricks and mortar. Therefore, the store being a brick and mortar center is obvious and does not hold patentable weight to the claim.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for a merchandise-return system to include brick and mortar centers with the motivation of processing return transactions for remote merchandisers of bricks and mortars.

Rogers fails to disclose and the distributed community of point-of-return associates generally provide retail mail, parcel and shipping services generally not directly competitive with the goods of the merchandisers, but does disclose point-of-return associates in the abstract, lines 3-5.

However, Kramer et al discloses and the distributed community of point-of-return associates generally provide retail mail, parcel and shipping services generally not directly competitive with the goods of the merchandisers, (Col. 30, lines 5-9, shows a return transaction captured by vPOS or the virtual point of sale, w/ col.15, lines 4-9, shows that when the cardholder/consumer places an order for goods, the shipping cost is presented. Kramer et al discloses this limitation in an analogous art for the purpose of showing that products that are returnable can be shipped. Kramer et al does not specifically disclose retail mail, or parcel, however, these are obvious with Kramer et al since Kramer et al discloses shipping services, which is also a delivery service like retail mail and parcel services.

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It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to provide retail mail, parcel and shipping services with the motivation of showing that delivery services are available with product-return systems.

As per claim 35, Rogers et al discloses:

wherein the merchandise-return information served by the information resource includes criteria for making either a positive or negative return decision and, in cases of positive return decisions, further comprise return fulfillment instructions, (Col. 8, lines 29-34, [represents the positive return decision shown by allowing a refund or exchange {represents the return fulfillment instructions} if the return is within 90 days after the purchase], Col. 8, lines 38-48, [represents the negative decision shown by not allowing a refund or exchange, but referring to a repair facility instead if the return is past the 90 day mark]).

As per claim 36, Rogers et al discloses:

wherein the merchandise-return information served by the information resource includes criteria for making either a positive or negative return decision and, in cases of positive return decisions, further comprise an award instruction applicable to the party presenting the return merchandise or else another party, which award instruction can be chosen from any of instant credit, credit provisional that the merchandiser certifies the propriety of the return upon a later date or event, credit honored by a given association of merchants only, a direct or otherwise refund in cash or equivalent, and/or any combinations thereof, (Col. 8, lines 29-48, [criteria based on how long ago the product was purchased], Col. 8, lines 32-34, [refund represents refund in cash or equivalent]).

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As per claim 37, Rogers et al discloses:

a distributed purchasing public of remote merchandisers' merchandise, (Col. 3, lines 61-64, [local retailer computer at a central station with links to registers at individual stores], w/ col. 4, lines 49-51, [where customer is shown to bring merchandise to the register for a product transaction, therefore, customers can be located at different individual stores]);

a plurality of remote merchandisers transacting sales accompanied in each instance by a form of record thereof, whereby the merchandisers likely desire greater physical distribution among their distributed purchasers...for sake of offering proximity for walk-in return service, (Col. 4, lines 7-13, [regional computer system for a large chain of stores], Col. 3, lines 59-61, [having the local computer system located in proximity to the register, thus making it advantageous and more effective for product transactions]);

a network of distributed point-of-return associates providing a network of distributed, physical stores in which to process the walk-in return business of the remote merchandisers, (Col. 3 lines 61-64, [retailer computer links to the registers at individual stores], w/ Col. 8, lines 8-19, [retailer {sales associate} cross-referencing the serial number of the product with the serial number on the receipt to verify the sales receipt]);

a merchandise-return information resource, providing an exchange of information with the point-return associates over a communications medium, for serving responses to requests for merchandise-return information on merchandise presented for return to the point-of-return associates, (Col. 6, lines 62-66, [shows EDI translator, which

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represents the communications medium], Col. 8, lines 54-Col. 9, line 16, [displaying product descriptions upon return to sales associate where the information comes from a store-wide database and a manufacturers national database]); and

an out-sourced merchandise-return program devised such that the point-of-return associates accept the walk-in returns of the merchandisers' merchandise in conformance with the merchandise-return information served by the information resource, (Abstract, lines 1-3, [facilitates authorized product returns], w/ Col. 8, lines 20-36, [where records are represented by information in the retailer/manufacture database and the authorization is represented by making sure qualifications are met where criteria is represented by qualifications], w/ Col. 4, lines 24-26, [where database is shown to store transaction information about merchandise]);

The following is not disclosed by Rogers:

of brick-and-mortar centers

However, brick and mortar centers are in the same category as a store. For example, Home Depot is a store where a consumer can buy and/or return bricks and mortar. Therefore, the store being a brick and mortar center is obvious and does not hold patentable weight to the claim.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for a merchandise-return system to include brick and mortar centers with the motivation of processing return transactions for remote merchandisers of bricks and mortars.

Rogers et al fails to disclose one of electronic or non-electronic forms of records attached to returnable units of merchandise during or before order fulfillment wherein the forms facilitate research of information with the information resource, but does disclose a returnable unit of merchandise in the abstract, lines 11-14.

However, Kramer et al discloses:

one of electronic or non-electronic forms of records attached to returnable units of merchandise during or before order fulfillment wherein the forms facilitate research of information with the association service, (Col. 15, lines 2-10, electronic order form). Kramer et al discloses this limitation in an analogous art for the purpose of showing that a form pertaining to a transaction can be delivered electronically before the order is authorized and processed. In this case, attaching the form to the unit is obvious since the form can be created on the cardholder's computer, which has a printer for printing out the form, and it is standard practice to include a return order slip when returning merchandise in the parcel industry.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have one of electronic or non-electronic forms of records attached to returnable units of merchandise during or before order fulfillment wherein the forms facilitate research of information with the association service with the motivation of making information about the return readily accessible.

As per claim 38, Rogers et al discloses:

wherein the electronic forms of records comprise codes which when scanned decode into a URL. address and the request to be processed by the information

resource, (Col. 7, lines 34-49, [on-line summary report listing all serial numbers accepted or rejected following validation of serial numbers]).

Response to Arguments

4. Applicant's arguments, see page 8, lines 17-20, filed 9/14/04, with respect to the rejection(s) of claim(s) 24, 31, and 37 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Hence, the rejection for claims 23, 25-26, 28-30, 32-33, 35-36 and 38-40 have also been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Rogers et al, (US 6,018,719), in further view of Kramer et al (US 6,324,525).

Conclusion


5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 703-305-1340. The examiner can normally be reached on Monday-Tuesday 8:30am-5pm, and Wednesday, 8:30 am-12:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238 [After final communications, labeled "Box AF"], 703-746-7239 [Official Communications], and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



A. R. B.
November 18, 2004



TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600